

In the Drawings:

Please delete the drawing sheet as filed containing Figures 7A and 7B and replace the deleted drawing sheet with the new Replacement Sheet provided. The Examiner will note that Figure 7B has been deleted. Consequently, Figure 7A has been renumbered as Figure 7.

REMARKS

Reconsideration and withdrawal of all grounds of rejection are respectfully requested in view of the above amendments and the following remarks. Claims 19-23 and 26-27 were rejected. By entry of this amendment, claims 19-22 have been cancelled without prejudice or disclaimer. New claims 28-29 have been added. Consequently, claims 23 and 26-29 are pending.

The Examiner has objected to Figures 6, 7A and 7B. Specifically, the Examiner stated that the contents of Figure 7B appear to be inconsistent with what is shown in Figures 6 and 7A. In response, Figure 7B has been deleted and Figure 7A has been renumbered as Figure 7.

The Examiner objected to claims 19-22 because of various informalities. Claims 19-22 have been cancelled without prejudice or disclaimer. Consequently, this objection is now moot.

The Examiner has rejected claim 19-22 under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Ryan, Shipman and Wick. Claims 19-22 have been cancelled without prejudice or disclaimer. Consequently, this objection is now moot.

The Examiner has rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over Shipman in view of Wick. Claim 20 has been cancelled without prejudice or disclaimer. Consequently, this objection is now moot.

The Examiner has rejected claim 21 under 35 U.S.C. 103(a) as being unpatentable over Shipman in view of Wick, and further in view of Anderson. Claim 21 has been cancelled without prejudice or disclaimer. Consequently, this objection is now moot.

Claim 23 has been amend to better define the invention. Claim 23 is directed to a two piece lockout device that has telescoping and rotational capability. The device forms a single

enclosed structure over valves and other similar connections. The claim recites:

an inner piece and an outer piece, each of the inner piece and the outer piece having an arcuate outer surface and an arcuate inner surface, wherein said inner piece and said outer piece are telescopically and rotationally engaged such that said inner piece is substantially nested within said outer piece when said lockout device is in an opened position and substantially extended from within said outer piece when said lockout device is in a closed position;

an arcuate rail projecting from approximately the center of the outer surface of said inner piece;

an arcuate track formed within the inner surface of said outer piece, at approximately the center of said inner surface, wherein said rail slides along said track to provide telescopic and rotational movement of said inner and outer pieces; and

an interlock, wherein said interlock includes a crossmember that engages a portion of the track when said lockout device is in the closed position, wherein said engagement of said crossmember and said portion of the track prevents further telescopic and rotational movement of said pieces beyond said closed position. (emphasis added)

The Examiner has rejected claim 23 under 35 U.S.C. 103(a) as being unpatentable over Shipman in view of Howisen and Wilk. The combination of these three references does not teach or suggest all the limitations of claim 23 as amended. Specifically, none of the cited references teach, disclose or suggest the limitation of an arcuate track formed within the inner surface of the outer piece, at approximately the center of said inner surface, wherein the rail slides along the track to provide telescopic and rotational movement of the inner and outer pieces.

Moreover, the undersigned respectfully submits that the Examiner has not established a showing of *prima facie* obviousness. To establish a *prima facie* case of obviousness, there must be some reason, suggestion, or motivation, found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. MPEP § 2143, *In Re Oetiker*, 977 (Fed. Cir. 1993). *Prima facie* obviousness can only be established when motivation to combine is found explicitly or implicitly in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. MPEP § 2143.01. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” MPEP § 2143.01, *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references).

The Office Action asserts that the motivation “to provide a T-shaped rail and closed interlock track at the center pieces of Shipman, in view of the teachings of Howisen and Wilk, [is] to increase the stability of the connection between the pieces of Shipman.” However, the Office Action has failed to identify any teaching in the prior art providing a T-shaped rail and closed interlock track at the center of the pieces would increase stability. As a result, the Office Action has not relied upon any objective evidence or any factual findings in making its conclusory assertion of motivation. Consequently, *Prima facie* obviousness has not been established, because the Office Action has not identified any source for the asserted motivation. (MPEP 2143.01)

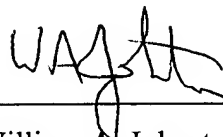
For at least the above-discussed reasons, claim 23 is allowable and the undersigned respectfully requests reconsideration.

The remaining pending dependent claims are allowable at least based on direct or indirect dependence on allowable independent claim 23.

In view of the above amendments and remarks, it is respectfully submitted that all pending claims of this application are in condition for allowance. Accordingly, a Notice of Allowance for all pending claims of this application is respectfully solicited. Furthermore, if the Examiner believes that additional discussions or information might advance the prosecution of this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

Date: 5/30/06



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